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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,411	07/07/2006	Seung-Kyoon Noh	3566-0113PUS1	2743

2292 7590 07/06/2010
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EXAMINER

MCCLELLAND, KIMBERLY KEIL

ART UNIT	PAPER NUMBER
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1791

NOTIFICATION DATE	DELIVERY MODE
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07/06/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 10/585,411	Applicant(s) NOH, SEUNG-KYOON	
	Examiner KIMBERLY K. MCCLELLAND	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. Applicant is reminded they need to explicitly point out where support for all the newly claimed features comes from as required by MPEP 714.02 and 2163.06. See 37 CFR 1.111.

Claim Objections

2. Claim 18 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. As previously stated, the term “clamp shaft” is interpreted to mean a “rotational shaft”. Applicant has not provided any further clarification as to the meaning of this term. Therefore, claims 18 reciting a rotational shaft serving as a clamp shaft fails to further limit independent claim 14.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 14-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed,

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had possession of the claimed invention. The limitation of the ejector roll assembly “contacting only individual tapes and not said sheets” is found to be new matter. The mere absence of a positive recitation in the original specification is not basis for the exclusion of a feature. *Ex Parte Grasselli* 231 USPQ 393,394. (Bd. App. 1983).

Applicant has not identified where support for this feature may be found in the specification as originally filed. Clarification is required.

5. Claim 25 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation of the box being “in the tape cassette” is found to be new matter. The specification describes the box as being external, not internal. Applicant has not identified where support for this feature may be found in the specification as originally filed. Clarification is required. For the purposes of examination, examiner assumes the box structure is included as part of the tape cassette, and therefore is “in” the tape cassette.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 18, 22, and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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8. The term “clamp shaft” in dependent claim 18 is unclear. It is unclear what structure is being recited. Based on the limited disclosure of the current specification, the term “clamp shaft” is interpreted as meaning “rotational shaft” as illustrated by element 91 in Figure 6.

9. The term “fork pipe” in claims 22 and 25 is unclear. It is unclear what structural feature is being recited. Based on the limited disclosure of the current specification, the term “fork pipe” is being interpreted to mean “roller” as illustrated by element 122 in Figure 9.

10. An applicant is entitled to be his or her own lexicographer and may rebut the presumption that claim terms are to be given their ordinary and customary meaning by clearly setting forth a definition of the term that is different from its ordinary and customary meaning(s). See *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994). Any special meaning assigned to a term “must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.” *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998). See also *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999).

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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11. Claims 23-24 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,065,894 to Garland.

12. With respect to claim 23, Garland discloses a dispenser, including a tape cassette having a tape roll (1) with tapes inserted between two sheets; and a tape cassette driver (6) driving the tape cassette, wherein the tape cassette includes a first rotational shaft (28) rotatably supporting the tape roll, a second rotational shaft (24) designed to collect one of the two sheets by winding the same in a roll type, a third rotational shaft (25) designed to collect the other of the two sheets by winding the same in a roll type, and a tape ejection roller assembly (2/3) outwardly ejecting a tape from which the two sheets are removed, and the tape cassette driver is designed to drive the second and third rotational shafts (See Figures 1-2) a tape cassette driver driving the tape cassette, the tape cassette driver including: a first driving gear (30); a second driving gear (32) configured to rotate the second rotational shaft (24); and a third driving gear (33) configured to rotate the third rotational shaft (25), wherein the rotation of the first driving gear drives the rotation of the second and third driving gears; and a support frame (50) disposed between the tape cassette and the tape cassette driver (see Figures 3-4).

13. Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. Ex parte Thibault, 164 USPQ 666, 667 (Bd. App. 1969). Consequently, the tape and two sheets are not further limiting to the currently claimed apparatus.

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14. This rejection is based on the fact the apparatus structure taught above has the inherent capability of being used in the manner intended by the Applicant. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959).

15. As to claim 24, Garland discloses the tape ejection roller includes a tape feeding roller, and wherein the tape cassette driver includes a fourth driving gear (31) configured to rotate the tape feeding roller (See Figures 1-4).

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 14, 16, 18, and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,065,894 to Garland in view of U.S. Patent Application Publication No.2004/0079476 to Gayoso.

18. With respect to claim 14, Garland discloses a dispenser, including a tape cassette having a tape roll (1) with tapes inserted between two sheets; and a tape cassette driver (6) driving the tape cassette, wherein the tape cassette includes a first rotational shaft (28) rotatably supporting the tape roll, a second rotational shaft (24) designed to collect one of the two sheets by winding the same in a roll type, a third

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rotational shaft (25) designed to collect the other of the two sheets by winding the same in a roll type, and a tape ejection roller assembly (2/3) outwardly ejecting a tape from which the two sheets are removed, and the tape cassette driver is designed to drive the second and third rotational shafts (See Figures 1-2). Garland does not specifically disclose the tape ejector roller assembly contacting only said individual tapes and not said sheets.

19. Gayoso discloses a coating device, including an ejector roller assembly contacting only said individual tapes and not said sheets (86/88; See Figure 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the tape ejector roller assembly which does not contact the release sheets as taught by Gayoso with the device of Garland. The motivation would have been to propel the tape segments independently of the peel rate of the device (paragraph 0032).

20. Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. Ex parte Thibault, 164 USPQ 666, 667 (Bd. App. 1969). Consequently, the tape and two sheets are not further limiting to the currently claimed apparatus.

21. This rejection is based on the fact the apparatus structure taught above has the inherent capability of being used in the manner intended by the Applicant. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959).

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22. As to claim 16, Garland discloses the second and third rotational shafts are simultaneously driven by a timing belt (38; See Figure 1).

23. As to claim 18, Garland discloses the first rotational shaft serves as a clamp shaft (28; See Figure 1).

24. As to claim 21, Garland discloses the ejection roller assembly includes a tape feeding roller (2/3), and the tapes are outwardly ejected by the feeding roller (See Figure 1).

25. As to claim 22, Garland discloses the tape roll (1) is fixed to a first fork pipe (29) having a through hole at the center, ends of the sheets are respectively fixed to second (4) and third fork pipes (5) each having a through hole at the center, and the first to third fork pipes are fixed into an external box (51) which is built to allow the first, second and third fork pipes to be respectively fixed to the first, second and third (28/24/25) rotational shafts through the respective through holes (See Figure 1).

26. Claims 14-15, 17-18, and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 7,077,289 to Ross in view of U.S. Patent Application Publication No.2004/0079476 to Gayoso.

27. With respect to claim 14, Ross discloses a dispenser, including a tape cassette having a tape roll (120) with tapes inserted between two sheets; and a tape cassette driver (160/170) driving the tape cassette, wherein the tape cassette includes a first rotational shaft (122) rotatably supporting the tape roll, a second rotational shaft (142) designed to collect one of the two sheets by winding the same in a roll type, a third

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rotational shaft (152) designed to collect the other of the two sheets by winding the same in a roll type, and a tape ejection roller assembly (131) outwardly ejecting a tape from which the two sheets are removed, and the tape cassette driver is designed to drive the second and third rotational shafts (See Figure 4). Ross does not specifically disclose the tape ejector roller assembly contacting only said individual tapes and not said sheets.

28. Gayoso discloses a coating device, including an ejector roller assembly contacting only said individual tapes and not said sheets (86/88; See Figure 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the tape ejector roller assembly which does not contact the release sheets as taught by Gayoso with the device of Ross. The motivation would have been to propel the tape segments independently of the peel rate of the device (paragraph 0032).

29. Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. Ex parte Thibault, 164 USPQ 666, 667 (Bd. App. 1969). Consequently, the tape and two sheets are not further limiting to the currently claimed apparatus.

30. This rejection is based on the fact the apparatus structure taught above has the inherent capability of being used in the manner intended by the Applicant. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959).

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31. As to claim 15, Ross discloses idle roller shafts (shafts of rollers 131) provided in the vicinity of the ejection roller assembly to simultaneously pass through the sheets and the tapes (See Figure 4).

32. As to claim 17, Ross discloses the second and third rotational shafts (142/152) are capable of having a rotational speed different from each other (see Figure 4).

33. This rejection is based on the fact the apparatus structure taught above has the inherent capability of being used in the manner intended by the Applicant. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959).

34. As to claim 18, Ross discloses the first rotational shaft serves as a clamp shaft (122; See Figure 4).

35. As to claim 21, Ross discloses the ejection roller assembly includes a tape feeding roller (131), and the tapes are outwardly ejected by the feeding roller (see Figure 4).

36. As to claim 22, Ross discloses the tape roll (120) is fixed to a first fork pipe (121) having a through hole at the center, ends of the sheets are respectively fixed to second and third fork pipes (141/151) each having a through hole at the center, and the first to third fork pipes are fixed into an external box (110) which is built to allow the first, second and third fork pipes to be respectively fixed to the first, second and third rotational shafts through the respective through holes (See Figure 4).

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37. Claims 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 7,077,289 to Ross as applied to claims 14-15, 17-18, and 21-22 above, and further in view of U.S. Patent No. 5,694,629 to Stephenson, III et al.

38. With respect to claim 19, Ross discloses one of the second and third rotational shafts (142/152), which is capable of a rotational speed faster than the other. However, Ross does not specifically disclose torque limiter means.

39. Stephenson et al. discloses a film winding shaft, including torque limiter means (36; See Figures 1 and 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include torque limiting means on both winding shafts of Ross as taught by Stephenson et al. The motivation would have been to prevent damage to the sheet (column 1, lines 5-10).

40. As to claim 20, Ross does not specifically disclose the torque limiter means are of resilient arms.

41. Stephenson et al. discloses a film winding shaft, including torque limiter means of resilient arms (36; See Figures 1 and 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include torque limiting means of resilient arms on both winding shafts of Ross as taught by Stephenson et al. The motivation would have been to prevent damage to the sheet (column 1, lines 5-10).

42. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 7,077,289 to Ross in view of U.S. Patent No. 4,194,646 to Oglander et al.

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43. With respect to claim 14, Ross discloses a dispenser, including a tape cassette having a tape roll (120) with tapes inserted between two sheets; and a tape cassette driver (160/170) driving the tape cassette, wherein the tape cassette includes a first rotational shaft (122) rotatably supporting the tape roll, a second rotational shaft (142) designed to collect one of the two sheets by winding the same in a roll type, a third rotational shaft (152) designed to collect the other of the two sheets by winding the same in a roll type, and a tape ejection roller assembly (131) outwardly ejecting a tape from which the two sheets are removed, and the tape cassette driver is designed to drive the second and third rotational shafts (See Figure 4) and a box (110) for holding the tape roll, the box being located in the tape cassette, the box including: a first fork pipe (121) having a through hole at the center, the first fork pipe supporting the tape roll, a second fork pipe (141) having a through hole at the center, the second fork pipe having an end of one of the two sheets fixed thereto; and a third fork pipe (151) having a through hole at the center, the third fork pipe having an end of the other of the two sheets fixed thereto (See Figure 3). Ross does not specifically disclose the box includes a through hole corresponding to each of the first, second, and third fork pipes such that the first, second and third rotational shafts extend therethrough and are received in the corresponding through hole of the first, second, and third fork pipes, respectively.

44. Oglander et al. discloses a dispensing machine, including the shafts (12) are connected to the housing (1') via openings in the housing (see Figures 1-3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the arrangement of a shaft contained within openings of the housing as

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taught by Oglander with the first, second, and third rotational shafts in the device of Ross. The motivation would have been to effectively connect the shaft to the housing, while allowing for freedom of rotation (column 3, lines 27-45).

45. Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. Ex parte Thibault, 164 USPQ 666, 667 (Bd. App. 1969). Consequently, the tape and two sheets are not further limiting to the currently claimed apparatus.

46. This rejection is based on the fact the apparatus structure taught above has the inherent capability of being used in the manner intended by the Applicant. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959).

Response to Arguments

47. Applicant's arguments with respect to claims 14-25 have been considered but are moot in view of the new ground(s) of rejection.

48. With respect to applicant's arguments regarding the use of the terms "clamp shaft" and "fork pipe", these arguments are not persuasive. Applicant has not supplied a definition for these features. Applicant has not specified if the presumed definitions supplied by the examiner are indeed accurate interpretations of the terms. The meanings of these terms remain unclear. Furthermore, newly added claim 18 appears to distinguish a clamp shaft from a rotational shaft, but applicant has not identified what

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features are included in this term. Therefore, the rejections are maintained.

Clarification is required.

49. With respect to applicant's arguments that Garland fails to disclose driving gears, or a support frame, examiner disagrees. See a first driving gear (30); a second driving gear (32) configured to rotate the second rotational shaft (24); and a third driving gear (33) configured to rotate the third rotational shaft (25), wherein the rotation of the first driving gear drives the rotation of the second and third driving gears; and a support frame (50). Therefore, this argument is not persuasive.

Conclusion

50. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to KIMBERLY K. MCCLELLAND whose telephone number is (571)272-2372. The examiner can normally be reached on 8:00 a.m.-5 p.m. Mon-Thr.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip C. Tucker can be reached on (571)272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kimberly K McClelland/
Examiner, Art Unit 1791

KKM

/Philip C Tucker/
Supervisory Patent Examiner, Art Unit 1791